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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,094	12/27/2001	Sekharipuram R. Narayanan	06816-044003	2464

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FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

EXAMINER

TSANG FOSTER, SUSY N

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,094

Applicant(s)

NARAYANAN ET AL.

Examiner

Susy.N Tsang-Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 7-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-6 in Paper No. 3 is acknowledged.
2. Claims 7-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 3.

Information Disclosure Statement

3. The information disclosure statements filed 12/27/2001 have been considered. However, a copy of 892 form from case 09/305,249 does not appear to be a proper IDS because it is not a separate listing for the present case. The references cited therein are cited in an 892 form for the present case.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

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the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not enable one of ordinary skill in the art to prepare a catalyst material that has an increased surface area by introducing a substance that is insoluble in the catalyst material and subsequently removing the insoluble substance from the catalyst material to increase a surface area of the catalyst material compared to the catalyst material prior to introducing and removing the substance because the specification does not disclose what non-ionic surfactants are used as the substance that is insoluble in the catalyst material, or at what high temperature the non-ionic surfactant is removed. The specification does not provide sufficient guidance to one of ordinary skill in the art to achieve the claimed invention without undue experimentation to determine what non-ionic surfactant and high temperature are meant by applicants. It is also unclear how the non-ionic surfactant would be selectively removed at a high temperature without destroying the perfluorovinylether sulfonic acid and polytetrafluoroethylene in the catalyst material.

Furthermore, the specification does not appear to support the limitation of increasing a surface area of the catalyst material by introducing a substance in the catalyst material that is insoluble in the catalyst material since the specification on page 18 states that the surface area of the catalyst is increased, not the surface area of the catalyst material which comprises the catalyst. It is also unclear in paragraph 69 of the specification whether metals such as zinc, aluminum, or tin are the non-ionic surfactants that are volatilized at a high temperature to produce an increased surface area catalyst.

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It is also unclear how the zinc, aluminum, or tin is incorporated into the catalyst since the catalyst is normally a noble metal carried on a porous carbon support and the specification does not provide any details on page 18, paragraph 69. Nonetheless, the specification on page 18 does not enable one of ordinary skill in the art to increase the surface area of the catalyst by temporarily introducing a substance that is insoluble in the catalyst and remove by subsequent volatilizing at a high temperature considering the state of the art of increasing the effective surface area of a catalyst for fuel cell applications.

For example, US Patent No. 5,068,161 states:

"It is well known that increasing the effective surface area of the catalyst increases catalyst performance. There are several ways in which this may be achieved. Increasing the amount of supported catalyst in the electrode will increase the total effective surface area of active catalyst material. However, this increases the thickness of the fuel cell electrode, increasing internal resistance, thus reducing the overall benefit. Alternately, the weight percent of active metal supported on the carrier may be increased. This allows for an increase of the total amount of active catalyst material in the electrode without increasing the electrode thickness. However, the dispersion of the active metal must be retained at higher loading for this to be effective. It would therefore be very advantageous to make supported Pt alloy catalysts with higher metal loading than is currently practised with useful dispersion (active surface area per weight of metal), preferably at least equivalent to current practice. It has become accepted in the fuel cell catalyst art that a "standard" catalyst formulation comprises approximately 7 to 11% by weight platinum, by itself or as an alloy, on carbon because of the difficulty in achieving useful dispersions of higher metal loading by normally available techniques. The prior art contains many statements concerning the desirability of high surface area, and there are some suggestions that catalysts may be made at weights of up to 20 or 30% by weight total metal on carbon. There are, however, no instances of such high loading Pt alloy catalysts being exemplified in a convincing manner. In particular should be mentioned the techniques described by Stonehart et al in "Modern Aspects of Electrochemistry" Vol. 12, 183 et seq, and Stonehart states that it is possible to reach Pt loadings of 2 to 40 wt % in single component catalysts, using very high surface area carbon blacks (J. Electroanal. Chem., 261 (1989), p375)." (col. 1, line 50 to col. 2, line 19).

As evidenced by US Pat. No. 5,068,161, the effective surface area of the catalyst is conventionally increased by increasing the amount of catalyst that is loaded onto a high surface area carbon support.

It also appears that applicants are confusing the issue between the catalyst itself which is conventionally a noble metal or alloy supported on carbon and a catalyst material comprising catalyst, carbon support and binder. The use of the term "catalyst" and "catalyst material" appears to mean two different things in the present specification and in the claims. The Examiner is interpreting the term "catalyst material" to mean a catalyst mixture comprising catalyst, carbon support, and binder in light of claim 2 and applicant's specification. Applicant's specification does not disclose increasing the surface area of the catalyst material comprising perfluorovinyl ether sulfonic acid and polytetrafluoroethylene and instead on page 18 of the specification discloses the statement that the "catalyst" is increased in surface area by temporary introduction of a substance insoluble in the catalyst and removable by subsequent leaching may be used to increase the surface area of the catalyst and such a substance can be a surface active substance which will prevent particle agglomeration and can be volatilized at a higher temperature and that non-ionic surfactants may be preferable.

There are no details given as to how the non-ionic surfactant is temporarily introduced into the catalyst and it is unclear what compounds encompass non-ionic surfactants. Applicant also state on page 18 of the specification that the metals such as zinc, aluminum, or tin incorporated in the catalyst during preparation can also serve this function. It is unclear from the previous statement in the specification whether applicant is stating the zinc, aluminum, or tin can be non-ionic surfactants. However, it is unclear what is meant by incorporating zinc, aluminum, or tin in the catalyst during preparation if the zinc, aluminum, or tin is insoluble in the catalyst. If zinc, aluminum, or tin is incorporated during the preparation of the catalyst, the zinc, aluminum, or tin is not temporarily introduced into the catalyst as stated in the specification on

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page 18 but instead, the zinc, aluminum, or tin is introduced into the catalyst precursor during preparation of the catalyst. It is also unclear how the zinc, aluminum or tin is subsequently removed from the prepared catalyst at a high temperature if it is incorporated into the catalyst without destroying the catalyst.

Hence, it is unclear how an insoluble substance is introduced into the catalyst material and then subsequently removed to increase the surface area of the catalyst material.

6. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not appear to support the limitation of increasing a surface area of the catalyst material by introducing a substance in the catalyst material that is insoluble in the catalyst material since the specification on page 18 states that the surface area of the catalyst is increased, not the surface area of the catalyst material which comprises the catalyst and other binder components.

Furthermore, the original disclosure does not disclose any of the limitations of claims 2-6 since the catalyst and not the catalyst material was increased in surface area by adding and removing an insoluble substance as stated on page 18 of the specification.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the limitation "increase a surface area of the catalyst material" is indefinite because it is unclear how the area of the catalyst material is increased since a catalyst material is defined in dependent claim 2 as a mixture comprising several components such as catalyst, perfluorovinylether sulfonic acid and polytetrafluoroethylene.

Claims depending from claims rejected under 35 USC 112, second paragraph are also rejected for the same.

Conclusion

Any inquiry concerning this communication or earlier communications should be directed to examiner Susy Tsang-Foster, Ph.D. whose telephone number is (703) 305-0588. The examiner can normally be reached on Monday through Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached at (703) 308-2383. The phone number for the organization where this application or proceeding is assigned is (703) 305-5900.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

st/ *Susy Tsang Foster*

Susy Tsang-Foster
Primary Examiner
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